

## **REMARKS/ARGUMENTS**

By this paper, Applicant replies to the Office Action of July 9, 2007 and respectfully requests reconsideration of the application.

Claims 1-41 are now pending, a total of 41 claims. Claims 1, 3, 6, 8, 9, 11, 14 and 16 are independent.

### **I. Paragraphs 1 and 2 of the Action**

Paragraphs 1 and 2 of the Office Action are not understood. Applicant requests that the Examiner consult MPEP § 706.02(I) through (I)(3), in particular the sample language recommended by the Office at MPEP § 706.02(I)(2)(II), and the Office's assignment database. After that review, Applicant requests a plain statement of any conclusions that follow. Applicant is unaware of any written document that would give the Examiner authority to state that she has "not been persuaded that Ginsberg was in fact owned by eSpeed" in view of Applicant's compliance with Office Guidelines.

If any ground of rejection could be raised within the authority delegated to an examiner by the Office, Applicant requests that it be stated squarely, so that Applicant has fair notice of any obligation to rebut, and a precise issue to which to reply. If no ground of rejection can be stated within that authority, Applicant requests that the next Office Action expressly withdraw the first sentence of Paragraph 2, so that the record is clear.

Applicant requests compliance with established written procedures, and that there be no improvisation – improvisation leaves the record unclear, and impedes compact prosecution.

### **II. Pages 2-3 of the Action**

Pages 2-3 of the Action mention the words "obviousness type double patenting," but do not state any rejection. If any rejection is thought to apply, Applicant requests that it be stated squarely and precisely in the manner required by the MPEP, so that Applicant has full and fair notice of the precise issue, and a meaningful opportunity to reply. In order to raise an obviousness-type double patenting rejection, MPEP § 804(B)(1) requires the following:

- Form paragraph 8.33 may not be used alone. The notes to form paragraph 8.33 note that 8.33 must be accompanied by any one of form paragraphs 8.34 to 8.39. This was not done. No double patenting rejection exists.
- Identify at least one one-to-one pair of particular claims between the current application and the Ginsberg '799 publication. For example, MPEP § 804(B)(1) instructs that when making an obvious-type double patenting analysis, the following factual inquiries must be set forth (underlined added):
  - (A) Determine the scope and content of a patent claim [singular] relative to a claim [singular] in the application at issue;
  - (B) Determine the differences between the scope and content of the patent claim [singular] and the prior art as determined in (A) and the claim [singular] in the application at issue;The Office Action makes no showing of how any one of the claims of the current application correspond to any single one of the claims of the Ginsberg '799 publication. Until a particular claim of this application is shown to attempt to "patent" something already "patented" by a particular claim of the Ginsberg '799 publication, or an obvious variant thereof, there can be no double patenting. Without this discussion, no rejection exists.
- Identify the precise difference between the pairs of claims. MPEP § 804(B)(1) instructs:

Any obviousness-type double patenting rejection should make clear:

  - (A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; ...The Office Action sets out no comparison whatsoever between any claims. No rejection exists.
- Once that difference is identified, make an obviousness showing. MPEP § 804(B)(1) instructs:

Any obviousness-type double patenting rejection should make clear: ...

  - (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent.Obviousness is shown using the procedure set out at MPEP § 2143 *et seq.*: (a) motivation to modify or combine, (b) reasonable expectation of success, and (c) every element known in the prior art. The Office Action makes no such showings. No rejection exists.

Without an identification of a particular issue and the required showings, Applicant cannot meaningfully respond. When a rejection is not stated with sufficient specificity to permit a response, no rejection exists. Applicant requests compliance with established, predictable written procedures set forth in the MPEP, without improvisation.

### III. Paragraph 5 of the Office Action

Paragraph 5 of the Action discusses claims 1 and 9 in the context of Silverman '583. The Office Action does not make an element-by-element comparison between any claim and

Silverman '583; rather, the Office Action merely quotes claim 1, with no discussion, and then in an entirely separate section, observes that Silverman '583 happens to use a few isolated words from claim 1. The Office Action makes no attempt to comply with MPEP § 2131, by showing that Silverman '583 contains “[t]he identical invention ... shown in as complete detail as is contained in the ... claim. The elements must be arranged as required by the claim...”

Further, portions of Silverman '583 noted in the Action cannot possibly be relevant to these claims. For example, here is Silverman '583, col. 1, lines 20-40:

Among the players on the floor of an exchange are specialist and floor brokers. Specialist call out the best bid and ask prices received from the various brokers, ensures that trades are posted, facilitate trades, and acts to ensure liquidity. Floor broker rooms the trading floor and acts as an agent to transacts orders on behalf of investors (buyers and sellers).

A typical transaction originates when an order is placed with an off-the-floor-trading desk (a.k.a. a "trading booth") to buy or sell a particular security. The trading desk may then convey the order to a exchange clerk who notes the parameters of the order including whether the order is a buy or sell order, the symbol of the security, the quantity, the price, any special conditions associated with the order, and the time that the order is placed. The clerk then delivers the order to the floor broker for execution. Traditionally, the orders are transcribed onto order slips that are delivered to the floor brokers by pages or runners. The floor broker then executes the order, notes the executed order on a slip of paper, and subsequently returns the notated slip of paper to the clerk via a runner.

Silverman '583, col. 1, lines 20-40 discusses a traditional trading floor, where communications are effected by “roaming,” that is, walking, by “slips of paper,” and by “calling out,” that is, voice. The Office Action is silent on any conceivable relevance of this embodiment to anything other than a few isolated words of claim 1.

Likewise, the Office Action states that a proposition is supported by some unidentified statement in Silverman's “Disclosure of the Invention.” 37 C.F.R. § 1.104(c)(2) requires:

*(c)Rejection of claims.*

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Silverman's “Disclosure of the Invention” is over two full columns. This is not “as nearly as practicable.” Because there has been no attempt to comply with § 1.104(c)(2)'s rules of examination, there is no rejection.

The Office Action is too incomplete and divorced from the claim language and the PTO's procedural rules to permit a direct reply. No rejection exists. Any discussion of the claim language will necessarily be a "new ground of rejection."

#### **IV. Other claims**

All discussions of other claims rely on the discussion of claim 1 above. Because no element-by-element showing was made with respect to the other claims of the application, and the portions of Silverman '583, col. 1, lines 20-40 cannot possibly be relevant, no rejections of these other claims are stated with sufficient precision or procedural completeness to permit a reply. No rejections exist.

It is also noted that the Office Action's discussions of the other claims fails to squarely address the claim language – instead the Action considers only a few isolated words and loose paraphrases. There is no element-by-element back-and-forth between the claims and the references to clearly state reasons, as required by § 1.104. No rejections exist.

Applicant requests that there be no improvisation of new examination procedures. Applicant requests that any future Office Action provide limitation-by-limitation comparisons of the claims to the references. MPEP § 2131 requires that interconnections and words of "arrangement" be given the same weight as nouns, and be shown to exist in the references.

The dependent claims have not been examined or rejected, for reasons similar to those discussed in connection with claim 1. In addition, the dependent claims recite additional features that further distinguish the art.

#### **V. Conclusion**

A Petition for Extension of Time extends the shortened statutory period through November 9, 2007. Accordingly, this reply is timely. In the event that further extension of time is required, Applicant petitions for that extension of time required to make this reply timely.

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to

resolve any condition that would impede allowance. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-3938, Order No. 01-1034.

Respectfully submitted,  
ESPEED, INC.

Dated: November 8, 2007

By: /David E. Boundy/  
Registration No. 36,461

110 East 59th St.  
New York, NY 10022  
(212) 294-7848  
(917) 677-8511 (FAX)